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REMARKS

I. Status of Claims

Claims 22-32 are pending in this application. Claim 23 has been amended to correct an obvious typographical error. Claims 33-42 have been canceled without prejudice or disclaimer. Support for this amendment is found in the originally filed specification. Thus, no new matter has been added by the amendment.

II. Objection to Claims

The Examiner objects to claims 27, 28, 30, 38, 39, and 41 for allegedly reciting improper alternative language. Office Action at 2. Applicants respectfully disagree with the Examiner's objection.

As stated in the M.P.E.P., an applicant may use "alternative expressions . . . or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought." M.P.E.P. § 2173.01. In this case, the phrase "X selected from A, B, and C" is proper language and more accurately describes the claimed invention, i.e., the composition may contain one or more X with each X is independently selected from the group A, B, and C. For example, both Applicants' language and the Examiner's proposed language cover a composition of the invention that may contain: A; A and B; or two A's, two B's and a C, as well as all other permutations. Applicants' claim language is more clear, and the Examiner has shown no legal basis for requiring the Applicants to change it.

The Office has stated on more than one occasion that Applicants' language, "X selected from A, B, and C," is permissible language. First, the Examples provided in the PTO training materials clarify that "X selected from A, B, and C" is proper claim language:

- * Example H, entitled "Endothelin Receptor Antagonists" provides a model claim with alternative claim language that reads "at least one hetero atom selected from N, S and O."
- * Example J, entitled "Selectin-Mediated Cellular Adhesion" provides a model claim with alternative claim language that reads "wherein the substituent is selected from halogen, C1-4 alkyl, trifluoromethyl, hydroxy, and C1-4 alkoxy."

Training Materials For Examining Patent Applications with Respect to 35 U.S.C. Section 112, First Paragraph - Enablement Chemical/Biotechnical Applications, at Enablement Decision Tree, Nov. 5, 1996 (<http://www.uspto.gov/web/offices/pac/dapp/1pecba.htm>). Second, an Example provided in the M.P.E.P. also clarifies that "X selected from A, B, and C" is proper claim language:

- * Example 20 provides a model claim that states "wherein R1 is methyl or phenyl, X and Z are selected from oxygen (O) and sulfur (S)."

M.P.E.P., ADMIN. INSTRUCT. UNDER THE PCT (ANNEX B), at Example 20 (p. AI-71 to AI-72).¹

¹ The Example also shows that Applicants' claim language, "is A, B, or C" is permissible.

Accordingly, in light of the additional examples of proper alternative claim language provided by the PTO and the lack of argument to the contrary, it is clear that there is no reason for the Examiner to require the Applicants to change the claim language of the pending claims. Applicants respectfully request that this improper objection be withdrawn.

III. Rejection Under § 102(b)

The Office has rejected claims 33-42 under 35 U.S.C. § 102(b) as unpatentable over WO 97/00288 (WO '288) for the reasons disclosed at pages 2-3 of the Office Action. While Applicants disagree with the Examiner's reasoning, in view of the cancellation of claims 33-42, this rejection has been rendered moot.

IV. Rejections Under 35 U.S.C. § 103(a)

A. The Examiner has rejected Claims 22-31 under 35 U.S.C. § 103(a) over the "admitted prior art" in view of WO '288 for the reasons disclosed on pages 3-4 of the Office Action. Applicants respectfully traverse this rejection for at least the reasons set forth below.

The Office alleges that the prior art teaches an electric cable for transporting electric energy comprising at least one conductor and at least one insulating layer made of a crosslinked polymer material or elastomer. *Office Action*, page 3. The Office admits, however, that this prior art does not teach an insulating layer comprising the presently claimed elastomer composition. Accordingly, the Office relies on the teachings of WO '288 to provide this missing disclosure. Based on WO

288's alleged teachings of elastomers with improved mechanical properties, the

Office summarily concludes that:

[O]ne having ordinary skill in the art at the time the invention would have been motivated to utilize the elastomer composition taught by WO '288, having improved cure and mechanical properties, as the polymer insulating layer in the invention taught by the prior art.

Id., page 4. Applicants respectfully disagree.

In order to establish a *prima facie* case of obviousness, the Examiner must establish three basic criteria. Applicants respectfully submit that the Office has failed, at a minimum, to demonstrate that some suggestion or motivation existed, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

M.P.E.P. § 2143.01.

Importantly, the Federal Circuit has noted that the Office's burden to establish a *prima facie* case of obviousness may be satisfied by one of only three sources: the nature of the problem to be solved, the teachings of the prior art, and the general knowledge of one of ordinary skill in the art. M.P.E.P. § 2143.01. In this case, the Office has merely relied on the WO '288's alleged teaching of improved mechanical properties to sustain the rejection. But such a teaching does not support the "clear and particular" evidence required by law. *In re Dembiczak*, 50 U.S.P.Q.2d at 1617.

More importantly, there is no suggestion in the art that the polymers of WO '288 are suitable for the compositions of the prior art to yield Applicants' claimed invention, i.e., an electric cable comprising at least one conductor and at least one

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insulating layer, said insulating layer comprising a substantially lead-free polymer composition comprising as base polymer material an elastomer terpolymer.

First, contrary to the Examiner's assertions (Office Action at 4), WO' 288 does not suggest that its compositions are suitable for an electrical cable. WO '288 does disclose a variety of uses, but none of which is the claimed product.

Second, if the patentee of WO' 288 believed its compositions to be useful for an electrical cable, it would explicitly say so. A prime example is WO 97/00523, which was filed the same day, issued to the same Applicant, prosecuted by the same agent, and concerned similar ethylene, α -olefin, vinyl norbornene elastomers. Exxon Corporation, the common Applicant, explicitly and repeatedly stated that the elastomers of WO '523, which are all exemplified with lead, were suitable for covering electric cables. See, e.g., page 1. In stark contrast, Exxon Corporation did not provide this same description for the elastomers of WO '288, despite common inventor, common filing date, and common subject matter. Applicants submit that compositions comprising WO '288's elastomers differ and are not suitable for the electrical cable products claimed in claims 22-31.

Accordingly, for at least the foregoing reasons, Applicants maintain that there is no motivation to combine the reference and the prior art in the manner proposed by the Examiner and respectfully submit that this rejection should be withdrawn.

B. The Office has rejected claim 32 under 35 U.S.C. §103(a) as unpatentable over the alleged admitted prior art in view of WO '288 and further in view of EP 0 893 802 A1 ("EP '802"), for the reasons disclosed at page 4 of the

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Office Action. Applicants respectfully traverse the rejection for at least the reasons set forth below.

Applicants submit that the rejection of claim 32 is improper for the same reasons discussed above with respect to claims 22-31. In view of the explicit teachings of WO '523, it is apparent that the patentee for WO '288 did not consider the elastomers suitable for electrical cables. Applicants incorporate by reference the discussion above herein in full. Given that the Examiner's discussion of EP '802 does not correct that deficiency, Applicants respectfully request that this rejection be withdrawn.

C. The Examiner is impermissibly using hindsight. Only in hindsight could it have been obvious to one with the cited references before her to have combined their teachings in the claimed manner with a reasonable expectation of success. Examiners, however, may not pick and choose among isolated disclosures in references to defeat patentability of a claimed invention. Such picking and choosing amounts to improper hindsight reconstruction, and is prohibited. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q. 2d 1596, 1600 (Fed. Cir. 1988).

In the present case, the Examiner relies on the "admitted prior art" to teach all of the limitations missing from WO '288. However, as discussed above, one of ordinary skill in the art would not have been motivated to combine their teachings nor had a reasonable expectation of success in doing so.

Accordingly, Applicants submit that the Examiner is impermissibly using hindsight to piece together portions of very dissimilar references, notably not including any portion of the primary reference. This cannot reasonably be

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considered an appropriate basis for a rejection under § 103. Accordingly, for at least this additional reason, Applicants respectfully request withdrawal of these rejections.

In light of the foregoing, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness, and thus, request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

V. Conclusion

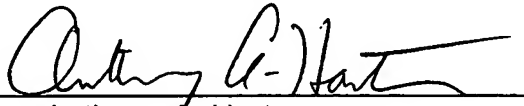
In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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